

### **REMARKS**

This amendment responds to the Office Action dated June 11, 2009. Claims 1, 2, 4-6, 44-51, 62, 63, and 65 are in the application. Claims 1, 44, and 62 are in independent form.

Reconsideration is respectfully requested in light of the following remarks.

### **Prior Rejection Status**

Applicants filed a Notice of Appeal and a Pre-Appeal Review Brief on March 4, 2009 in response to the Office Action dated September 4, 2008 rejecting all claims under 35 USC § 103 for obviousness over U.S. Pat. No. 6,611,806 to Harvey in view of U.S. Pat. No. 5,771,657 to Lasher and U.S. Pat. No. 5,593,267 to McDonald et al. The rejection was withdrawn in a Notice of Panel Decision from Pre-Appeal Brief Review dated March 30, 2009.

The current Office Action includes a duplication of the previously withdrawn rejection. Based upon the previous withdrawal of the same rejection in the Notice of Panel Decision from Pre-Appeal Brief Review, applicants understand the rejection for obviousness under 35 USC § 103 for obviousness over Harvey in view of Lasher and McDonald et al. to be an inadvertent duplication of the withdrawn rejection and do not further address it.

### **New Grounds of Rejection**

#### **35 USC § 101**

Claims 1, 2, 4-6, 44-51, 62, 63, and 65 are rejected under 35 USC 101 as being directed to non-statutory subject matter. The Examiner states that various steps recited in the claims are not tied to a machine and can be performed without a particular machine, citing In re Bilski, 88 USPQ2d 1385, Fed. Cir. (2008). Applicants respond as follows.

Independent claims 1 and 62 are amended to clarify that the step of associating the unique identifier of each tag with customer information and the step of automatically detecting the presence of the prescription orders are performed by or under control of the

computer system, as described in the application. Independent claim 44 currently recites associating the machine-readable tag with customer information associated with the prescription order in the computer system and that the computer system correlates the customer information, unique tag identifier, and storage area identifier. Applicant submits that claims 1, 44, and 62 clarify that these method steps are performed by a computer system, thereby tying the method steps to a particular machine.

Applicants note that claims 1 and 62 each further recites operably securing a separate machine-readable tag to each prescription order, moving the prescription orders by hand to a second location within the pharmacy, automatically detecting the presence of the prescription orders at the second location by reading the unique identifier of the remote tags with said second location tag reader, and moving each of the prescription orders by hand to one of the compartments in the array of compartments. Each of these steps is either tied to a machine (e.g., the second location tag reader) or transforms the underlying subject matter (e.g., by operably securing or moving it). Applicants submit that each of these steps and the amended subject matter, either alone or in combination, are sufficiently tied to a machine (e.g., a computer or a reader) or sufficiently transform underlying subject matter (e.g., moving or operably securing to it) that claims 1 and 62 and their respective dependent claims recite statutory subject matter under 35 USC 101.

Likewise, claim 44 further recites operably securing a machine-readable tag to the prescription order, manually filling the prescription order, and placing the filled prescription order and the machine-readable tag by hand into one individually identified storage area of the plurality of individually identified storage areas, and reading the unique tag identifier of the tag within the pharmacy worker selected storage area with a tag reader. Each of these steps is either tied to a machine (e.g., a tag reader) or transforms the underlying subject matter (e.g., by operably securing a tag or filling an order and placing it in a location). Applicants submit that each of these steps, either alone or in combination, are sufficiently tied to a machine (e.g., a computer or a reader) or sufficiently transform underlying subject matter (e.g., operably securing, filling, or placing) that claim 44 and its dependent claims recite statutory subject matter under 35 USC 101.

The claim at issue in In re Bilski is directed to a pure business method, namely, a

"method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price." No step in Bilski is tied to a particular machine (e.g., a computer) or transforms any article. The claim in Bilski is analogous to a pure algorithm. In contrast, applicants have shown in each of the independent claims multiple steps that are either tied to a particular machine or transform an article. Applicants have amended claims 1 and 62 to further clarify steps that are tied to a particular machine. No aspect of independent claims 1, 44, and 62 is remotely analogous to a pure algorithm like the claim in Bilski. Applicants request, therefore, that the rejection under 35 USC 101 be withdrawn.

### CONCLUSION

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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